



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/574,191 | 09/14/2006 | Frieder Grieshaber | 02894-750US1 06803 | 7141 |
| 26161 | 7590 | 06/01/2009 | | |
| FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | EXAMINER NGUYEN, TUAN VAN | |
| | | | ART UNIT 3731 | PAPER NUMBER |
| | | | NOTIFICATION DATE 06/01/2009 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/574,191 | Applicant(s) GRIESHABER ET AL. | |
| | Examiner TUAN V. NGUYEN | Art Unit 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 13, 15-20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13, 15-20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 were pending in this application. Claims 1-23 were examined and rejected in the Office action mailed out on 12/01/08.
2. This Office action is in response to the amendment filed on 2/27/2009.

Response to Amendment

3. According to the amendment, claims 10, 11, 14 and 21 have been canceled. Accordingly, claims 1-9, 12, 13, 15-20, 22 and 23 are pending in this present application and they presented for examination.
4. Claims 1-15 have been amended to overcome the rejection under 35 U.S.C. 101, therefore, the rejection is hereby withdrawn.
5. A new abstract is provided with the amendment. Examiner acknowledges no new matter is added to the new abstract.
6. Applicant's arguments with respect to the rejection of claims 1-10, 12, 13 and 15-23 under 35 USC § 102 have been fully considered but they are moot in view of new ground of rejection.
7. With respect to the rejection of claims 8, 11, and 14, applicant asks Examiner to provide evidence to support the rejection. In this Office action, Examiner provides specific factual findings to support the rejection.
8. On page 9 of the Remarks, applicant argues that because of the principle of operation of the invention of Magnus, providing a drive motor will not improve the

effectiveness of Magnus's device is incorrect. Examiner contends that it would be obvious to replace the thumb wheel 5 of Magnus et al with a drive motor to improve the efficiency of the device because it has been held that replacing mechanical component with electro-mechanical component to improve efficiency of the device is old and well known in the art.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claims 1-9, 12, 13, 15-20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magnus et al. (U.S. 2,423,245) in view of**

**Floessholzer et al. (US Pub. No. 2006/0004383 A1) further in view of
Avrahami et al (US 5,133,722).**

12. Magnus discloses (see Fig. 5) a method of removing hair by using an epilator 1 comprising a tape 7, pressure device 20 for applying the tape against the skin, the tape is fed from the pressure device to the deflector devices 8 and the opposing corner of 8. The epilator also includes supply reels 2 and take-up reel 4 (col. 3, line 65 to col. 4, line 29). Magnus discloses the invention substantially as claimed except for the two deflector elements are rotatably suspended, the drive motor which drive the take-up reel, and the drive motor is activated when the epilator apparatus is applied against the skin. However, in an alternative embodiment (Fig. 6) discloses the roller 33 or deflector element is rotatably suspended. It has been held that substitution of one known element for another to obtain predictable result is old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to replace the deflectors as disclosed in Fig. 5 with two deflector as disclosed in Fig. 6.
13. However, Floessholzer discloses using drive motor to drive the supply and take up tape. It has been held that replacing mechanical component with electro-mechanical component to improve efficiency of the device is old and well known in the art. Therefore, it would have been obvious to replace the thumb wheel 5 of Magnus et al with a drive motor to improve the efficiency of the device.
14. However, Further, Avrahami discloses (Figs. 1-2) a device of removing hair from a skin, comprising, among other things: a drive motor with sensor for actuating the

Art Unit: 3731

drive motor (col. 1, lines 54-58). It would have been obvious to one of ordinary skill in the art to provide a sensor mechanism to actuate the drive motor only when it is in the position that ready to operate as taught by Avrahami to the device of Magnus/Floessholzer to improve the effectiveness of the device.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

Art Unit: 3731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
5/26/09